



01 OCT 2007

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

BROWN & MICHAELS, PC
400 M & T BANK BUILDING
118 NORTH TIOGA ST
ITHACA NY 14850

In re Application of
HOSHINO et al.
Application No.: 10/591,843
PCT No.: PCT/JP05/04301
Int. Filing Date: 11 March 2005
Priority Date: 11 March 2004
Attorney Docket No.: KUP-12
For: PROTEASE INHIBITOR AND
PREVENTIVES OR REMEDIES FOR DISEASES

DECISION ON
PETITION UNDER
37 CFR 1.497(d)

This is a decision on applicant's Request to Add to Originally Named Inventorship, filed on 09 August 2007 in the United States Patent and Trademark Office (USPTO), requesting the addition of Junji Yodoi and Hajime Nakamura as inventors in the above reference application.

BACKGROUND

On 05 September 2006, applicant filed a Transmittal Letter requesting entry into the national stage in the United States of America under 35 U.S.C. § 371 with, *inter alia*, the requisite basic national fee.

On 18 June 2007, a Notification of Missing Requirements was mailed to applicant indicating, *inter alia*, that an oath or declaration, in compliance with 37 CFR 1.497(a) & (b), and the surcharge for filing the oath or declaration after the thirty month period, was required.

On 30 July 2007, applicant filed a response to the Notification of Missing Requirements along with a declaration executed by inventors Hoshino and Aizawa, identified in the published international application.

On 09 August 2007, applicant filed a petition for correction of inventorship to add Junji Yodoi and Hajime Nakamura as inventors. In addition to the \$130 petition fee, Petitioner provided the statements of the inventors Junji Yodoi and Hajime Nakamura in support of the correction of inventorship under 37 CFR 1.497(d).

DISCUSSION

Where the oath or declaration filed pursuant to 35 U.S.C. 371(c)(4) and 37 CFR 1.497(d) names an inventive entity different from the inventive entity set forth in the international application, the oath or declaration must be accompanied by: (1) a statement from each person being added as an inventor that any error in inventorship occurred without deceptive intention on

his or her part; (2) the fee set forth in § 1.17(g); and (3) if an assignment has been executed by any of the original named inventors, the written consent of the assignee(s) (See 37 CFR 3.73(b)).

Junji Yodoi and Hajime Nakamura were not named as inventors in the published international application PCT/JP05/04301. The declaration submitted on 09 August 2007 identifies Tomoaki Hoshio and Hisamichi Aizawa as co-inventors but fails to identify the added inventors on the same declaration.

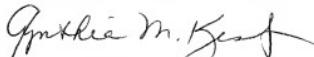
The declarations filed on 30 July and 09 August 2007 do not meet the requirements of 37 CFR 1.497 (a) and (b) and are unacceptable as filed. The declarations do not identify all the named inventors. The declaration filed on 30 July 2007 names only those inventors identified on the published international application. The declaration filed on 09 August 2007 names only those inventors identified in the instant petition. What is required is a complete declaration which identifies all the inventive entities and is executed by all named inventors (including those who have been added). The declaration must state the citizenship, residency and mailing address of each of the respective inventors. Accordingly, applicant has not met all of the requirements of 37 CFR 1.497(d) to add Junji Yodoi and Hajime Nakamura as inventors in the above-identified international application.

CONCLUSION

The declaration executed by Junji Yodoi and Hajime Nakamura as inventors and the declaration executed by Tomoaki Hoshio and Hisamichi Aizawa named in the above referenced application are unacceptable and are not in compliance with 37 CFR 1.497(a) and (b). A newly executed declaration, in compliance with 37 CFR 1.497(a) and (b), which identifies all inventors, is required.

For the reasons discussed above, the submission under 37 CFR 1.497(d) to add Junji Yodoi and Hajime Nakamura as inventors is hereby **DISMISSED without prejudice.**

Applicant is required to file a newly executed declaration(s), in compliance with 37 CFR 1.63 and 1.497(a) and (b) within the time limit of one month from the date of this letter or within the time remaining in the response period of the Notification of Missing Requirements, whichever is longer. NO EXTENSION OF THIS TIME MAY BE GRANTED UNDER EITHER 37 CFR 1.136(a) OR (b) BUT THE PERIOD FOR RESPONSE SET IN THE NOTIFICATION OF MISSING REQUIREMENTS MAY BE EXTENDED UP TO A MAXIMUM OF FIVE MONTHS.



Cynthia M. Kratz
Attorney Advisor
PCT Legal Office

Telephone: (571)272-3286
Facsimile: (571)273-0459